

C. REMARKS

Status of the Claims

Claims 1, 3, 6-9, 12-14, 16-20, 23-25, 27-31, 34-39, 41-44, and 46-49 are pending in the application. No claims are currently amended. Claims 54-56 are cancelled in the present response.

Interview Summary

On February 27, 2007 at 3PM EST, Applicants representative, Amy Pattillo, conducted a telephone interview with Examiner Gold. No exhibits were shown or demonstrations were made.

Applicants requested a clarification of which reference teaches the server system which facilitates the messaging session between client systems that applies the digital watermark to message entries, wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems. The Examiner referred to col. 2, lines 28-43 of Botham and Figure 2, element 218 as reading on the element, which are the same portions of Botham cited in the rejection. Applicants' representative asserted that Botham only describes a server system which applies a watermark or digital signature to a document, but that Botham does not teach the server system applying a watermark to a document indicating the client system from which the document originated. Applicants noted that because Botham does not teach this, even if the server in Botham is modified to facilitate a messaging session, the combination still does not teach a server system watermarking a message to identify the client system from which the message originated. The Examiner noted that he would examine the reference again in view of arguments presented in this response.

In addition, Applicants requested clarification whether the Examiner would interpret the limitation of wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate

client systems if claim 1 where rewritten to read “applying, at at least one server system, a separate digital watermark identifying a separate origin of each separate message entry from among said plurality of separate client systems.” The Examiner stated that the amendment incorporating the wherein clause would not change his interpretation of claim 1 and that wherein clause is interpreted as a limitation in claim 1. In reliance upon the Examiner’s statement that the wherein clause will be interpreted as a limitation of claim 1 and therefore that a prima facie case of obviousness requires a combination of references which teach the element of wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems, Applicants present the following arguments.

Claims 1-5, 8-16, 19-27, and 30-56 are not obvious under Botham in view of Okada

The Office Action rejects claims 1-5, 8-16, 19-27, and 30-56 under 35 U.S.C. §103(a) as being allegedly unpatentable over Botham, Jr. et al. (US Patent 6,785,812)(referred to herein as Botham) in view of Okada et al. (US Patent 6,393,461)(referred to herein as Okada). [Office Action, p. 2] Applicants note that claims 2, 4, 10, 11, 15, 21, 22, 26, 32, 33, 40, 45, and 50-53 were previously cancelled. Claims 54-56 are cancelled in the present response. Thus, the rejection as to claims 1, 3, 6-9, 12-14, 16-20, 23-25, 27-31, 34-39, 41-44, and 46-49 is respectfully traversed.

Claims 1, 14, and 25

Independent method claim 1, which is representative of system claim 14 and computer program product claim 25 with regard to similarly recited rejection, reads as follows:

1. (Previously Presented) A method, in at least one server system for enabling at least one real time chat messaging session channel via a network between at least a selection of a plurality of separate client systems communicatively connected to said network, for recording a real time chat messaging session, said method comprising the steps of:

applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated within said chat messaging session between said selection of said plurality of separate client systems, wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems; and recording, at said at least one server system, a log of said chat messaging session, wherein said log comprises said plurality of messaging entries with each said separate distinguishable watermark applied, such that an origin of each of said plurality of message entries stored in said log is traceable and the integrity of each of said plurality of message entries stored in said log is verifiable according to said distinguishable watermark.

Prima facie obviousness is not established because Botham in view of Okada does not teach or suggest each and every element of claims 1, 14, and 25

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, each of the elements of claims 1, 14, and 25.

As a preliminary matter, Applicants note that in the current rejection of claims 1 and 25, the Office Action cites Botham as reading on the elements of the claims other than “the use of message entries communicated within a chat messaging session and recording a log of said chat messaging session.” [Office Action, p. 3] In the rejection of claim 14, the Office Action cites Botham as reading on the elements of the claim other than “the use of a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of separate client systems communicatively connected to said network to facilitate said chat

messaging session and recording a log of said chat messaging session.” [Office Action, pp. 6-7] Claims 1 and 25 also include elements similar to claim 14 of “a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of separate client systems communicatively connected to said network to facilitate said chat messaging session.” The rejection of claims 1 and 25 and 14 seems only to vary in the fact that the Examiner does not interpret the limitations of claims 1 and 25 of “a method, in at least one server system for enabling at least one real time chat messaging session channel via a network between at least a selection of a plurality of separate client systems communicatively connected to said network” and “means for enabling at least one server system to facilitate at least one real time chat messaging session channel via a network between at least a selection of a plurality of separate client systems communicatively connected to said network to facilitate said chat messaging session.”

In considering whether Botham and Okada teach each and every element of claims 1, 14, and 25, regardless of whether the Examiner interprets claims 1 and 25 to include a limitation of a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of separate client systems communicatively connected to said network to facilitate said chat messaging session, Botham and Okada still do not teach each and every element of claims 1, 14, and 25. In particular, what is common in the rejection of claims 1, 14, and 25 is that none of the rejections point to any teaching on Botham of a server system applying separate digital watermarks to message entries communicated between client systems via the server system, where each separate distinguishable watermark, ***as applied by the server, identifies a separate origin of the message entry from among the client systems***. Further, Applicants respectfully assert that neither Botham nor Botham in view of Okada teaches or suggests each and every element of claims 1, 14 and 25 because neither reference teaches a server system which applies a watermark to a message entry to identify the client system originating the message entry. Claims 1, 14, and 25, however, teach a server system which applies a

watermark to a message entry to identify the client system originating the message entry because claims 1, 14, and 25 teach applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems.

In particular, the Office Action cites Botham, col. 2, lines 28-43 and Figure 2, ref 218 as reading on applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems and as describing “documents electronically distributed across a communication network wherein each document contains a watermark identifying its origin” and ref 218 as disclosing “said watermark applied at the server.” [Office Action, p. 3] Botham, col. 2, lines 28-43 states

“The invention provides for the secure and controlled electronic distribution of documents across a communication network, such as the Internet, for example. Advantages attainable therewith include the following: ...The document and its history and origin are trackable. Each document may contain specific identifiers, signatures, and/or “watermarks” that contain the validity and origin of the document. Such characteristics as the issuer, recipient date of origination, intended purpose, etc., may be tracked. The server may also be notified whenever the document is perused, how many times, and by whom.”

Even if this portion of Botham describes “documents electronically distributed across a communication network wherein each document contains a watermark identifying its origin” as stated in the Office Action, Botham does not teach a server system, facilitating document communication between client systems, applying the watermarks to identify the client system originating a document.

Applicants respectfully assert that merely because Botham describes that securely transferred documents in a network may contain a watermark identifying its origin, this

AUS920010396US1

portion of Botham and Botham as a whole does not teach or suggest one system applying a watermark to a communication to identify a second system from which the document originated. Claims 1, 14, and 25 describe a server system applying separate digital watermarks to message entries communicated between client systems via the server system, where each separate distinguishable watermark, ***as applied by the server, identifies a separate origin of the message entry from among the client systems.*** Thus, even though Botham describes that each document may contain a watermark with the validity and origin of the document, Botham does not teach the distinct element of applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems.

In addition, Applicants respectfully assert that Figure 2, element 218 of Botham, when Botham is viewed as a whole, does not teach or suggest applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems. Figure 2, element 218, refers to the process performed by the server of "sign document with unique signature." Within the specification of Botham, Figure 2 describes a process in which a client requests a document and "upon validating the request, server 102 retrieves the requested document 120 if it is already completed, or generates the requested document 120 from an information file and a document template if it is not completed, at step 214". *Botham*, col. 3, line 65-col. 4, line 2. In addition, Botham describes setting permissions for the client viewing the document and "server 102 signs document 120 with a unique signature 122, e.g. appends a unique serial number thereto, at step 218." *Botham*, col. 4, lines 10-13. The client system receiving the document, confirms receipt of the document, to the server, by returning

the document's signature. *Botham*, col. 4, lines 19-24. Thus, Figure 2 and the specification accompanying Figure 2, describe a server system which applies a unique signature to a document, however, *Botham* merely describes a server system which both originates a document and signs the document with a unique signature. *Botham*, Figure 2 and the accompanying specification, does not teach or suggest a server receiving a document from a client and applying a watermark to the document to identify the client system from which the document originated. Claims 1, 14, and 25, as previously noted teach a server system applying separate digital watermarks to message entries communicated between client systems via the server system, where each separate distinguishable watermark, ***as applied by the server, identifies a separate origin of the message entry from among the client systems.*** Thus, even though *Botham* describes that each document may contain a watermark with the validity and origin of the document, *Botham* does not teach the distinct element of applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems.

Further, the combination of *Botham* and *Okada* does not teach or suggest applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems. The Office Action states that *Botham* teaches all the limitations of claims 1 and 25 except "the use of the message entries communicated within a chat messaging session and recording a log of said chat messaging session" and of claim 14 except "the use of a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of separate client systems." [Office Action, pp. 3, 6] The

Office Action cites Okada as teaching these limitations. Applicants respectfully assert, however, that neither Botham nor Okada teaches a server system that applies a watermark to a communication where the watermark identifies the client system originating the communication. Applicants note the Office Action focuses on Botham as describing a server system which applies a watermark, however, if Botham only teaches a server system applying a watermark and Okada teaches a server system for facilitating message entries in a messaging session, the combination of the references still does not teach or suggest a server system applying separate digital watermarks to message entries communicated between client systems via the server system, where each separate distinguishable watermark, ***as applied by the server, identifies a separate origin of the message entry from among the client systems.***

Therefore, because Botham in view of Okada does not teach or suggest all the elements of applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated between said selection of said plurality of separate client system, wherein each said separate distinguishable watermark identifies a separate origin of said message entry from among said plurality of separate client systems, the Office Action fails to establish a prima facie case of obviousness as to claims 1, 14, and 25 and the claims should be allowed.

**There is no suggestion or motivation to modify Botham by Okada to teach claims
1, 14, and 25**

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Botham by Okada must come from the teachings the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re*

Vaeck, 947 F.3d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Applicants respectfully assert that there is no suggestion or motivation for the modification of Botham by Okada to teach a method, in at least one server system for enabling at least one real time chat messaging session channel via a network between at least a selection of a plurality of separate client systems communicatively connected to said network (claim 1), a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session (claim 14, or means for enabling at least one server system to facilitate at least one real time chat messaging session channel via a network between at least a selection of a plurality of separate client systems communicatively connected to said network to facilitate said chat messaging session (claim 25). As previously noted, the Office Action states that Botham teaches all the limitations of claims 1 and 25 except “the use of the message entries communicated within a chat messaging session and recording a log of said chat messaging session” and of claim 14 except “the use of a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of separate client systems.” [Office Action, pp. 3, 6] In addition, the Office Action cites Okada as describing “a communication management system for a chat system provided in a computer network including a plurality of client workstations and a server computer linked thereto (see abstract). Okada teaches the use of a chat system with a log file wherein said chat system is used with a plurality of client workstations and a server computer (col. 1, line 50-col. 2, line 13).” [Office Action, p. 3] The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Botham in view of Okada to use message entries communicated within a chat messaging session and recording a log of

said chat messaging session. One would be motivated to do so because a chat session is a quicker way of communication." [Office Action, p. 4, 7]

Applicants respectfully assert that the Examiner's proposed modification of Botham by Okada to teach a messaging server for enabling a chat messaging session channel via the network between multiple client systems would first require a motivation or suggestion for modifying Botham's document management server to enable communication between the client systems communicatively connected to the document management server and then would require a motivation or suggestion for modifying Botham's modified system to teach Okada's messaging system. There is no suggestion or motivation for both of these modifications.

First, Applicants respectfully assert there is no motivation or suggestion for modifying Botham's document distribution system to facilitate communications between any client systems communicatively connected to the document distribution server. Botham describes a document distribution server which controls communication between a client system and a server system to transfer a document from the server system to the client system. *Botham*, col. 1, lines 50-67. The server system in Botham may communicate with and transfer documents to different client systems (Botham, col. 2, line 18), however, no portion of Botham teaches the server system facilitating document transfer from one client system to another client system. Furthermore, Botham teaches away from providing a channel for communication between client systems by specifically teaching a distribution system that encrypts documents transferred from the server to the client so that no other system is able to read the document. Botham, col. 4, lines 12-22. Thus, regardless of whether there is motivation for modifying Botham to enable a chat session for a quicker way of communication between a client system and a server system, there is not any suggestion or motivation for modifying the document distribution system of Botham, which specifically secures documents distributed from the server to a client, to instead facilitate communication between multiple client systems. Further, there is no suggestion or motivation for modifying Botham to teach a document distribution server that facilitates real-time

communication between multiple client systems in a chat messaging session, and in fact, Botham teaches away from such a modification.

Second, Applicants respectfully assert that even if there were suggestion or motivation for modifying Botham's document distribution system to facilitate communication between client systems, there is still no motivation or suggestion for modifying Botham by Okada. In particular, as previously stated, there is no motivation for modifying Botham's document distribution system, specifically designed to secure distribution of a document by a server system to a particular client system, to instead teach a system for facilitating chat communications, even if secured, between the client systems communicatively connected to the server system.

Therefore, because there is no motivation or suggestion for modifying Botham or Botham in view of Okada to teach a server system for facilitating any kind of communication channel between multiple client systems, there is no suggestion or motivation for modifying Botham or Botham in view of Okada to teach a messaging server communication connected to a network, said messaging server for enabling at least one chat messaging session channel via said network between at least one a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Because there is no suggestion or motivation for modifying Botham by Okada to teach each and every element of claims 1, 14, and 25 a prima facie case of obviousness is not established and the claims should be allowed.

Claims 3, 8, 9, 12, 13, 19, 20, 23, 24, 30, 31, 34, and 35

As to claims 3, 8, 9, 12, 13, 19, 20, 23, 24, 30, 31, 34, and 35, Applicants respectfully assert that because the independent claims 1, 14, and 25 upon which dependent claims 3, 8, 9, 12, 13, 19, 20, 23, 24, 30, 31, 34, and 35 rely are not obvious in view of Botham and Okada, then the dependent claims 3, 8, 9, 12, 13, 19, 20, 23, 24, 30, 31, 34, and 35 are also not obvious in view of Botham and Okada and the dependent claims should be allowed.

Claims 5, 16, and 27

First, Applicants respectfully assert that because the independent claims 1, 14, and 25 upon which these dependent claims 5, 16, and 27 rely are not obvious in view Botham and Okada, then the dependent claims 5, 16, and 27 are also not obvious in view of Botham and Okada and the dependent claims should be allowed. Second, the rejection is respectfully traversed.

Claim 5, which is representative of claims 16 and 27 in grounds of rejection, reads:

5. The method for recording a chat messaging session according to claim 1, said step of applying, at said at least one server system, a separate distinguishable digital watermark further comprising the step of:

applying, at said at least one server system, a separate textual watermark to each of said plurality of message entries within said chat messaging session.

The Examiner states that Botham, col. 2, lines 28-43 read on the elements of claims 5, 16, and 27. [Office Action, p. 4] Applicants respectfully assert that Botham and Okada, separately or in combination, do not teach or suggest each and every element of claims 5, 16, and 27, and a prima facie case of obviousness is not established, because neither reference teaches applying a the digital watermark as a textual watermark.

Claims 1, 14, and 25 teach a server applying a digital watermark; claims 5, 16, and 27 teach the applied digital watermark is a textual watermark. While claims 5, 16, and 27 clearly limit a watermark to a textual watermark, however, the Office Action cites the same portion of Botham, col. 2, lines 28-43 as reading on claims 5, 16, and 27. Clearly, however, Botham, col. 2, lines 28-43 states that a document may contain a "watermark". A "textual watermark" is distinguishable from a "watermark" as indicated by the word "textual", which must be given some meaning. The Office Action does not provide any indication of what meaning is given to the term "textual", however the specification of the present invention distinguishes between types of digital watermarking including modifications to text, graphics, video or audio in a messaging session in such a way that the origin of the messaging session is traceable and the

integrity of the messaging session is later verifiable. *Specification*, paragraph 0036. Applicants respectfully assert, therefore, that because neither Botham nor Okada, nor the combination of references, teaches a textual watermark, the combination of references does not teach applying, at said at least one server system, a separate textual watermark to each of said plurality of message entries within said chat messaging session. Because at least one element of claims 5, 16, and 27 is not taught or suggested by Botham and Okada, separately or in combination, a prima facie case of obviousness is not established and the claims should be allowed.

Claims 36, 41, and 46

Claim 36, which is representative of system claim 41 and program product claim 46 with regard to similarly recited rejection, reads as follows:

36. A method, in a particular client system from among a plurality of clients systems enabled to communicate with one another through a chat messaging session channel facilitated by a chat messaging server via a network, for participating in a chat messaging session facilitated through said chat messaging session channel, said method comprising the steps of:

participating in a chat messaging session at said particular client system by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems; and

receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry

the burden of proving a prima facie case of obviousness as to 36, 41, and 45 for the following reasons.

Prima facie obviousness is not established because Botham in view of Okada does not teach or suggest each and every element of claims 36, 41, and 46

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, each of the elements of claims 36, 41, and 46.

Botham and Okada do not teach each and every element of claims 36, 41, and 46 because Botham and Okada do not teach a client system receiving a document or other communication from a server system, where the communication is watermarked to identify the client system from which the communication originated. In contrast, claims 36, 41, and 46 teach receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark.

In particular, the Office Action cites Botham, col. 2, lines 28-43 and Figure 2, ref 218 as reading on "a plurality of messaging entries as each messaging entry is entered

by a separate ones of a plurality of separate users participating; and wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems.” [Office Action, pp. 7-8] As previously noted, col. 2, lines 28-43 of Botham read:

“The invention provides for the secure and controlled electronic distribution of documents across a communication network, such as the Internet, for example. Advantages attainable therewith include the following: ...The document and its history and origin are trackable. Each document may contain specific identifiers, signatures, and/or “watermarks” that contain the validity and origin of the document. Such characteristics as the issuer, recipient date of origination, intended purpose, etc., may be tracked. The server may also be notified whenever the document is perused, how many times, and by whom.”

Figure 2, reference 218 describes a server system signing a document with a unique signature. Neither of these references to Botham, or Botham as a whole, however, teaches message entries or message entries embedded with a digital watermark identifying a separate origin of each of the message entries from among client systems, as stated in the Office Action. Thus, Botham does not read on “a plurality of messaging entries as each messaging entry is entered by a separate ones of a plurality of separate users participating; and wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems” as stated in the Office Action. Furthermore, claims 36, 41, and 46, even if applied in a server without instant messaging capability, teach a client system receiving a document or other communication from a server system, where the communication is watermarked to identify the client system from which the communication originated. Botham points to watermarked documents, but does not indicate how message entries would be watermarked, other than a unique signature by the server, which does not teach a watermark identifying the client system from which the message entry originated.

Further, the combination of Botham and Okada does not teach or suggest receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark.. The Office Action states that Botham teaches all the limitations of claims 36, 41, and 46 except "the use of the message entries communicated within a chat messaging session and recording a log of said chat messaging session." [Office Action, p. 8] The Office Action cites Okada as teaching these limitations. The Office Action does not point to any teaching by Botham or Okada of the actual elements of claims 36, 41, and 46 of receiving, at said particular client system, separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server. Even if it is assumed that Okada reads on this element, Applicants respectfully assert, however, that neither Botham nor Okada teaches a client system which receives watermarked communications, from a server, which indicate the client system from which the communication originated. As previously noted, claims 36, 41, and 46 teach a client system which receives watermarked communications, from a server, which indicate the client system from which the communication originated because claims 36, 41, and 46 teach receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark.

Therefore, because Botham in view of Okada does not teach or suggest all the elements of receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark, the Office Action fails to establish a prima facie case of obviousness as to claims 36, 41, and 46 and the claims should be allowed.

**There is no suggestion or motivation to modify Botham by Okada to teach claims
36 41, and 46**

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Botham by Okada must come from the teachings the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Applicants respectfully assert that there is no motivation or suggestion to modify Botham by Okada to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging

session. Furthermore, Applicants respectfully note that claims 36, 41, and 45 teach a particular client system, from among a plurality of client systems enabled to communicate through a chat messaging session facilitated by a messaging server. Applicants respectfully assert that there is no motivation or suggestion to modify Botham by Okada to teach a particular client system participating in a chat messaging session by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems.

In particular, the Examiner's proposed modification of Botham by Okada to teach a messaging server for enabling a real time chat messaging session channel via the network between multiple client systems and a particular client system for participating in a chat messaging session would first require a motivation or suggestion for modifying Botham's document distribution server to enable communication between the client systems communicatively connected to the document distribution server and then would require a motivation or suggestion for modifying Botham's modified system to teach Okada's messaging system. There is no suggestion or motivation for both of these modifications.

The Office Action cites Botham as teaching "a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating; and wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems." [Office Action, pp. 7-8] Botham is cited as failing to describe "the use of the message entries communicated within a chat messaging session and recording a log of said chat messaging session." [Office Action, p. 8] Okada is cited as describing "the use of a chat system with a log file wherein said chat system is used with a plurality of client workstation and a server computer." [Office Action, p. 8] The Office Action concludes that it "would have been

obvious to one of ordinary skill in the art at the time of the invention to modify Botham in view of Okada to use message entries communicated within a chat messaging session and recording a log of said chat messaging session. One would be motivated to do so because a chat session is a quicker way of communication." [Office Action, p. 8]

Applicants respectfully assert that the Examiner's proposed modification of Botham by Okada to teach a messaging server for enabling a chat messaging session channel via the network between multiple client systems would first require a motivation or suggestion for modifying Botham's document management server to enable communication between the client systems communicatively connected to the document management server and then would require a motivation or suggestion for modifying Botham's modified system to teach Okada's messaging system. There is no suggestion or motivation for both of these modifications.

First, Applicants respectfully assert there is no motivation or suggestion for modifying Botham's document distribution system to facilitate communications between the client systems communicatively connected to the document distribution server. Botham describes a document distribution server which controls communication between a client system and a server system to transfer a document from the server system to the client system. *Botham*, col. 1, lines 50-67. The server system in Botham may communicate with and transfer documents to different client systems (*Botham*, col. 2, line 18); however, no portion of Botham teaches the server system facilitating document transfer from one client system to another client system. Furthermore, Botham teaches away from providing a channel for communication between client systems by specifically teaching a distribution system that encrypts documents transferred from the server to the client so that no other system is able to read the document. *Botham*, col. 4, lines 12-22. Thus, regardless of whether there is motivation for modifying Botham to enable a quicker way of communication between a client system and a server system, there is not any suggestion or motivation for modifying the document distribution system of Botham, which specifically secures documents distributed from the server to a client, to instead facilitate communication between

multiple client systems. Further, there is no suggestion or motivation for modifying Botham to teach a document distribution server that facilitates real-time communication between multiple client systems in a chat messaging session or a client system that participates, via the document distribution server, in real-time communication with other client systems, and in fact, Botham teaches away from such a modification.

Second, Applicants respectfully assert that even if there were suggestion or motivation for modifying Botham's document distribution system to facilitate communication between client systems, there is still no motivation or suggestion for modifying Botham by Okada. In particular, as previously stated, there is no motivation for modifying Botham's document distribution system, specifically designed to secure distribution of a document by a server system to a particular client system, to instead teach a system for facilitating chat communications, even if secured, between the client systems communicatively connected to the server system.

Therefore, because there is no motivation or suggestion for modifying Botham or Botham in view of Okada to teach a server system for facilitating any kind of communication channel between multiple client systems, there is no suggestion or motivation for modifying Botham or Botham in view of Okada to teach a messaging server communication connected to a network, said messaging server for enabling at least one chat messaging session channel via said network between at least one a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Furthermore, in view of the foregoing, there is no suggestion or motivation for modifying Botham by Okada to teach a particular client system participating in a chat messaging session at said particular client system by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems. Because there is no suggestion or motivation for modifying Botham by Okada to teach each and every element of claims 36, 41, and 46, a prima facie case of obviousness is not established and the claims should be allowed.

Claims 37-39, 42-44, and 47-49

As to claims 37-39, 42-44, and 47-49, Applicants respectfully assert that because the independent claims 36, 41, and 46 upon which dependent claims 37-39, 42-44, and 47-49 rely are not obvious in view of Botham and Okada, then the dependent claims 37-39, 42-44, and 47-49 are also not obvious in view of Botham and Okada and the dependent claims should be allowed.

Claims 6, 7, 17, 18, 28, and 29 are not obvious under Botham and Okada, in view of Rodriguez

The Office Action rejects 6, 7, 17, 18, 28, and 29 under 35 U.S.C. §103(a) as being allegedly unpatentable over Botham and Okada in view of Rodriguez (US Patent 6,650,761). [Office Action, pp. 11] The rejection is respectfully traversed.

Claims 6 and 7, which are representative of system claims 17 and 18 and program product claims 28 and 29, respectively, with regard to similarly received rejection, read:

6. The method for recording a chat messaging session according to claim 1, said step of applying a separate distinguishable digital watermark further comprising the step of:

applying a separate graphical watermark to each of said plurality of message entries within said chat messaging session.

7. The method for recording a chat messaging session according to claim 1, said step of applying a separate distinguishable digital watermark further comprising the step of:

applying a separate audible watermark to each of said plurality of message entries within said chat messaging session.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a prima facie case of obviousness as to claims 6, 7, 17, 18, 28, and 29 for the following reasons.

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Botham and Okada by Rodriguez must come from the teachings the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Applicants respectfully assert that there is no motivation to modify Botham and Okada by Rodriguez because there is no motivation to modify a chat messaging server for digitally watermarking individual data message entries with an optical system for detecting a watermark stenographically encoded onto an object or paper product (Rodriguez, abstract, col. 1, lines 45-55). Claims 6, 7, 17, 18, 28, and 29, when each viewed as a whole, teach a chat messaging server for facilitating a chat messaging session between multiple client systems and digitally watermarking each message entry with either a graphical or audible digital watermark. Rodriguez describes an optical system that detects watermarks on objects or paper products. Rodriguez, abstract, col. 1, lines 45-55). In addition, the Examiner states that “Rodriguez teaches systems using such optical interfaces to control computers, and to navigate over or act as portals in networks (see abstract).” Applicants respectfully assert that merely because Rodriguez, col. 44, lines 66-67 describes a data field of an audio watermark and Rodriguez, col. 53, lines 51-58 describes the library of data, including icons, that can be selected to be embedded, there is no automatic motivation or suggestion to modify any system that teaches watermarking to also teach applying a graphical watermark or audible watermark. Further, there is no motivation or suggestion for modifying a chat messaging system that digitally watermarks message entries with an optical system,

which though connected to a network, still scans watermarks from products. Therefore, because there is no motivation or suggestion to combine Rodriguez with Botham and Okada or to combine Rodriguez with the teachings of claims 1, 14, and 25, a prima facie case of obviousness is not established under 35 USC 103(a) in claims 6, 7, 17, 18, 28, and 29 and the claims should be allowed.

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

By /Amy J. Pattillo, Reg. No. 46,983/
AMY J. PATTILLO
Registration No. 46,983
P.O. BOX 161327
AUSTIN, TEXAS 78716
ATTORNEY FOR APPLICANTS
Telephone: 512-402-9820
Facsimile: 512-306-0417